

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 17-32 have been cancelled in favor of new claims 33-52. These new claims address the objection to the claims and to address the 112, second paragraph rejections. Claim 33 is the same as cancelled claim 17 with the added element of “comprising a backing layer, an adhesive layer and a releasable protective layer”; support for this element can be found in the publication for this application on page 1, [0001] and page 2, [0018].

No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE OBJECTIONS TO THE CLAIMS HAVE BEEN OVERCOME

The objections to claims 17-32 have been rendered moot in light of the cancellation of claims 17-32 (the claims dependencies have been corrected for new claims 33-52).

III. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 17 and 20-32 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention, but have been rendered moot in light of the cancellation of claims 17-32 (It is believed that new claims 33-52 address the rejections of claims 17 and 20-32).

IV. THE 35 U.S.C. 101 REJECTION HAS BEEN OVERCOME

The rejection to claims 32 has been rendered moot by the cancellation of this claim.

V. THE 35 U.S.C. 102(b)/103(a) REJECTION HAS BEEN OVERCOME

Claims 17-21 were rejected as allegedly being anticipated or as being obvious over Schafer et al. (US Patent No 4,424,808 - “Schafer”). The applicants request reconsideration of

this rejection for the following reasons to the extent that it would be alleged that claims 33-39 would also be rejected by Schafer.

A. Schafer does not anticipate the applicants' claimed invention

Anticipation requires that all elements of the applicants' claimed invention be described in the prior art reference AND that the identical invention must be shown in as complete detail as is contained in the claim. *See MPEP 2131*. Schafer fails to meet these requirements for establishing anticipation.

1. All elements have not been taught

In addition to the difference in elasticity which is further described below, the applicants' invention differs from the Schafer in other regards.

First, the applicants' claimed bandage is used for supporting joints whereas Schafer describes a bandage which is "easily tearable" (either in the weft or warp direction) and has a "crepe structure" – see Abstract – which is not indicative of a bandage which is useful for supporting joints.

Second, the adhesive layer of the applicants' claimed bandage has an adhesion force of 0.1-100 N which is not taught by the Schafer reference.

2. Identical invention not shown in as complete detail as in applicants' claim

To the extent that the Office Action is relying on the teaching within col. 7, line 66 – col. 8, line 4 of Schafer for the teaching of an adhesive layer, it is noted that this passage does not only does not teach an adhesion force of 0.1-100 N, but fails to disclose to one of ordinary skill in the art the combination of an adhesive layer with an adhesion force of 0.1-100 N **and** a backing layer with an elasticity of 20% to 150% **and** that such a combination would provide for a bandage suitable for use in supporting joints.

3. No basis for claim of inherency

A weave comprises of a warp and a weft. Schafer refers only the warp or the weft as being "highly longitudinally elastic" (see e.g., col. 1, lines 36-43). In contrast, the applicants' claim is referring to the backing layer as having an elasticity of 20% to 150% (see applicants' claims 36-39 for narrower ranges of elasticity).

Therefore, there is no direct comparison of elasticity of Schafer's warp or weft with the elasticity of the applicants' backing layer.

Furthermore, with regard to inherency, attention is directed to MPEP 2112, sec. IV (Requirements of Rejection Based on Inherency; Burden of Proof) states in part “*The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.*” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted).

Even if Schafer had been referring to a backing layer as in the applicants’ invention, extrinsic evidence was not presented which established the inherency of the 20% to 150% elasticity element for the backing layer of the applicants’ claimed invention. This extrinsic evidence is even more relevant as it is clear that the elasticity referred to by Schafer is a different part of the applicants’ claimed invention.

Closing

For any of the above reasons, Schafer does not anticipate the applicants’ claimed invention.

B. Schafer does not render the applicants’ claimed invention to be obvious

Since Schafer has additional unaddressed differences as described above in section A. with the applicants’ claimed bandage, the applicants’ claims are unobvious as all elements must be taught or suggested by the prior art reference or from knowledge available to those of skill in the art.

Furthermore, the explanation regarding elasticity for the purposes of obviousness is akin to an “optimization of ranges” argument. However, there is no teaching for elasticity as being a results effective variable from within Schafer or any direction for optimizing the variable.¹

¹ MPEP 2144.05 section II (Optimization of Ranges) states that “A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).”

With regard to new claims 40-52 which are parallel to previous claims 22-32, it is noted that establishing a *prima facie* case of obviousness extends not only to the independent claim, but to all dependent claims cited in the rejection.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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